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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/727,678

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Richard M. Ehrlich

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05/30/2006

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EXAMINER

KO, DANIEL BOKMIN

ART UNIT

PAPER NUMBER

2189

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Period for Reply

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers.

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This action is responsive to the application filed on December 4, 2003. Claims 1-16 have been submitted for examination.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to retrieving the critical data from the FLASH memory, classified in class 711, subclass 103.
- II. Claims 9-11, drawn to detecting if any of plurality of FLASH ports is connected to a FLASH integrated circuit, classified in class 711, subclass 149.
- III. Claims 12-16, drawn to detecting a low power state then storing the critical data in a FLASH memory, classified in class 711, subclass 105.

Inventions I, II, and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as used in the system that retrieving the critical data from the FLASH memory. Subcombination II has separate utility such as used in the system that detecting if any of plurality of FLASH ports is connected to a FLASH integrated circuit.

Art Unit: 2189

Subcombination III has separate utility such as used in the system that detecting a low power state then storing the critical data in a FLASH memory. See MPEP § 806.05(d).

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant's election without traverse of claims 12-16 over the telephone restriction practice is acknowledged. Applicant's election was given in a telephone interview with Paul Durdik (Reg. #: 37,819) on May 12, 2006.

Claims 1-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Specification

The cross reference to related application of the disclosure is objected to because of missing U.S. Patent Application Number. Please provide U.S. Patent Application No. of all the related applications.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-10 of copending Application No. 10/727,773. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 6-10 of Application No. 10/727,773 are doing same function as claims 12-16 of present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Watts (U.S. Patent 6,336,161 B1).

Regarding claim 12, Watts teaches a method for storing critical data on a hard drive, comprising:

detecting a low power state event (Fig. 2a, step 42; column 4, lines 9-13);

retrieving a critical data from the DRAM (Fig. 5; column 5, lines 38-44; column 6, lines 6-13);

storing the critical data in a FLASH memory on the hard drive (Fig. 2a, step 44; column 2, line 33-36; column 4, lines 13-19); and

powering down the DRAM (Fig. 2a, step 48; column 4, lines 24-25).

Regarding claim 13, Watts teaches a method, wherein storing the critical data further includes:

storing the critical data in FLASH memory (Fig. 2a, step 44; column 2, line 33-36; column 4, lines 13-19); and

entering write data into a log, the write data indicating that critical data was read from the DRAM and written to the FLASH memory (Fig. 5; column 5, lines 38-44; column 6, lines 6-13).

Regarding claims 14 and 15, Watts teaches a method, further including:

transitioning the hard drive to a low power state or power off state (Fig. 2a, step 42; column 4, lines 9-13; column 4, lines 24-25).

Regarding claim 16, Watts teaches a method, further including:

identifying the critical data, the critical data stored on DRAM in the hard drive (Fig. 5; column 5, lines 38-44; column 6, lines 6-13).

Art Unit: 2189

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel B. Ko whose telephone number is 571-272-8194.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Reginald G. Bragdon can be reached on 571-272-4204. The fax phone number for the organization where this application or proceeding is assigned is 703-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Reginald G. Bragdon
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PRIMARY EXAMINER